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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,756	12/21/2001	Monica A. McClintic	5082US (01-01-057)	2572

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EXAMINER

MOSSER, ROBERT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/028,756

Applicant(s)

MCCLINTIC, MONICA A.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10-13-2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-44, 47-62, 65-78, 81-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-44, 47-62, 65-78, 81-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**



In response to the amendment filed October 13<sup>th</sup>, 2005.

Claims 41-44, 47-62, 65-78, and 81-94 are pending.

This action is Final.



***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **41**, **59**, and **77** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims **41**, **59**, and **77**, recites the limitation "the effect" in the new presented amendment included on the final line the cited claims. There is insufficient antecedent basis for this limitation in the claim. Further as presented it would be impossible for one of ordinary skill in the art to ascertain what is encompassed by "the effect".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **41, 42, 44, 47-60, 62, 65-78, and 81-94** are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (US 4,684,136) in view of Walker et al (6,193,606) in further view of Marnell (US 5,393,057).

*Discussion presented under the section entitled "Response to Arguments" below is incorporated herein.*

Regarding at least claims **41, 42, 44, 47, 48, 56-60, 62, 65, 66, 74-78, 81,82, and 90-94**, Turner teaches a game playable on a computer (Col 2:33-35) as well as between players (2:47-52) comprising: a display matrix including a plurality of spaces (Figure1); trivia topics assigned to and displayed in association with selected spaces of a matrix (14);

a randomly selected trivia question associated with each of said trivia topics and displayed upon the selection of one of said selected topics (Col 2:8-26 & Figure 4); a plurality of possible answers to said randomly selected trivia question presented to a player in association with the display of said randomly selected trivia question (Col 3:45-48) wherein the player is referred to a playing card for geographical or identification type questions;

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and an award associated with a player providing a correct answer to at least one of said trivia questions (Col 3:4-9) wherein the award described is the occupation of a space in the playing category by a playing piece.

The trivia matrix is understood to contain fewer trivia topics/questions than all of the spaces of the matrix as the game progresses (I.e. After one trivia question is answered correctly by a player that space is no longer available and hence no longer has a trivia topic associated therewith) and playable by at least two players (Col 2:47-52).

Turner is silent regarding the incorporation of this game as a bonus game (event to a base game) or the inclusion of wagering however, Walker et al teaches an electronic gaming device offering a game of knowledge for enhanced payouts including:

Allowing players to deposit (1104) and wager (1108) coins in a base game;

Automatically starting the trivia game after the conclusion of the base game (Figure 11);

Allowing players to choose their preferred trivia topic (550);

Providing the players with a question and possible answers (Figure 3B) after the start of the primary game (Figure 11) or bonus game as so claimed; and

Providing the player an award for correctly answering at least one trivia question (1156 & Figure 11).

Wherein when the player chooses not to provide an answer or pass (1172) a lower level award is presented to them (Abstract & Figure 11), hence yielding a "pass" in exchange for an amount of monies or game credits as claimed.

Walker et al additional teaches that his base game may consist of a variety of games including a reel game and a video poker game (Col 4:42-47).

Walker et al is however silent on the incorporation of a matrix allowing players to select the trivia topic from a matrix of topics.

It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the knowledge game of Turner with the knowledge game allowing enhanced payouts of Walker et al in order to allow the player to compete against other players during trivia rounds as taught by Turner (Col 2:47-52) and acquire prizes for successfully doing so.

As presently amended the invention of Turner/Walker is silent regarding "an initial display of the matrix having fewer than all of the plurality of spaces having a trivia topic associated therewith. In a related invention Marnell teaches the use of "wild" or free location with no trivia topic associated therewith (Figure 3 & Element 75) matrix location and the use of trivia questions to complete the matrix (Col 3:61-62). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a "wild" space as taught by Marnell in the invention of Turner/Walker to increase the probability of a player achieving a line combination.

Regarding at least claims **49**, **67**, and **83**, the matrix of Turner is understood to contain multiple smaller matrices and hence displays "another" matrix on both a correct previous answer as well as an incorrect previous answer by the player.

Regarding at least claims **50, 66, 68, and 84**, the game of Turner occurs in alternating turns between players repeating the general process described above (Col 3:1-9).

Regarding claims **51-53, 69-71, and 85-87** and in addition to the above stated, Turner teaches the winning outcome of the game as being based on completing the matrix in a tic-tac-toe fashion and as such dependent on completing the matrix in a pre-specified arrangement (Turner Abstract) but is silent on providing an award for this completion. Walker et al however teaches the awarding of a prize for correctly answering trivia questions as taught above. It would have been obvious to one of ordinary skill in the art at the time of invention to award a prize as taught by Walker in the game of Turner in order reward the player for winning the game.

Regarding claims **54, 55, 72, 73, 88 and 89**, and in addition to the above stated Walker et al teaches indicating both when the player has selected the correct answer and incorrect answer on the display of the game system but is silent as to the placement of the indicia on the display screen (Col 11:28-45).

Turner teaches the insertion of playing piece 16 into a spot on the board to indicate a correct answer.

It would have been obvious to one of ordinary skill in the art at the time of invention to place the indicia of Walker et al in the respective matrix positions of Turner

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to which the question corresponds in order to clearly identify the performance of the player to the player in addition to the reasons cited above.

Claims **43**, and **61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (US 4,684,136) in view of Walker et al (6,193,606) in further view of Marnell (US 5,393,057) in yet further view of Seelig et al (US 2003/0036418).

The game of Turner/Walker/Marnell as taught above is silent regarding allowing the player to choose if they would like to proceed to the bonus game (secondary game). This feature however, is taught by Seelig (Fig 3 & Elm 54) in a bonus slot gaming system. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the choice feature of Seelig into the game of Turner/Walker/Marnell in order to allow the player to play the bonus game when then choose to rather than being forced into the bonus game.

### ***Response to Arguments***

Applicant's arguments filed 10/13/2005 have been fully considered but they are not persuasive.

In regards to the applicants arguments directed towards the claim interpretation equating the "providing of an incorrect answer" to that of the applicant's claim "pass", the offices interpretation of such issues is clearly set forth in the following quote.

"Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,



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1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).< In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.")" –MPEP 2106 II

In the present case the incorporation of the examples set forth by applicant in their specification in order to further limit presented claim language is insufficient as the presented claim language would continue to encompass the applied process present in the rejection above. Hence while claims are interpreted in view of the specification they are not so limited by specification. If the applicant intends for functional separation between the two features presently in conflict they must provide such separation within the body of the claim language itself. As the prior interpretation and the present claim language continue to display functional equivalency the previously present rejection is maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

  
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TC3700